

REMARKS

Claims 1-26 are pending. By the present Amendment, Claims 1, 12, and 23 are amended and Claims 11 and 22 are canceled, thereby leaving Claims 2-10, 13-21, and 24-26 unchanged.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-8, 10, 12-19, 21, and 23-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. D377,303 (“Nagel”) in view of U.S. Patent No. 6,102,134 (“Alsruhe”). Claims 9 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagel in view of Alsruhe and further in view of U.S. Patent No. 4,976,173 (“Yang”). Claims 11 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,021,573 (“Kikuchi”) in view of Nagel. Claims 1-8, 10, 12-19, 21, and 23-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alsruhe in view of Nagel. Reconsideration of the rejections is respectfully requested.

Independent Claim 1 and dependent Claims 2-10

Claim 1 recites a power tool comprising a body housing a motor and a drive mechanism driven by the motor and providing a first grip surface, the body having a rearward end and defining a body axis, and a hand grip connected to the rearward end of the body, the hand grip providing a second grip surface and being supported for movement relative to the body between a first position, in which the first grip surface and the second grip surface are generally aligned, a second position, in which the second grip surface defines an obtuse angle with respect to the body axis, and a third position, in which the second grip surface is generally perpendicular to the first grip surface. Claim 1 specifies that the power tool is a reciprocating saw, and that the reciprocating saw further comprises a reciprocating spindle for supporting a tool element, the drive mechanism being operably connected to the spindle for causing reciprocation of the spindle.

As noted by the Examiner, Nagel does not teach or suggest a power tool including a body housing a motor and a drive mechanism driven by the motor. Nagel also does not teach or suggest a reciprocating saw including a reciprocating spindle for supporting a tool element, the drive mechanism being operably connected to the spindle for causing reciprocation of the spindle. Rather, the hand drill of Nagel includes a rotary drive arrangement for *rotating* a chuck

and a bit supported in the chuck. Moreover, given the lack of any disclosure regarding the interior of the drill of Nagel, only through speculation is it possible to image how a drive mechanism and a motor could be arranged within the drill of Nagel and how these and other elements would be electrically connected while allowing pivoting movement of the drill.

In addition and as explained in more detail below, given the lack of disclosure, it is impossible to imagine how these unseen elements would be modified to include the elements of the claimed invention. For these and other reasons, Nagel does not teach or suggest the subject matter of Claim 1.

The Examiner argues that “[i]t would have been obvious to one of ordinary skill in the art to modify [the drill of] Nagel by providing the power tool with a motor, a drive mechanism, a switch assembly, a wire arrangement, a locking mechanism, an actuator, and a biasing means to achieve a workable power tool as taught by Alsruehe.” As explained below in more detail, Applicants respectfully disagree and submit that Alsruehe does not cure the deficiencies of Nagel. Moreover, Applicants respectfully submit that the Examiner fails to explain how the various elements, including a motor, a drive mechanism, a switch assembly, a wire arrangement, a locking mechanism, and an actuator would be arranged within the housing of the hand drill of Nagel if the screwdriver were modified as suggested by the Examiner and how power would be transmitted between these elements without allowing any wires to be pinched during pivoting. Presumably, the Examiner is suggesting that these elements would be arranged within the housing of the hand drill of Nagel in a manner similar to that disclosed in the screwdriver of Alsruehe. However, as explained below, the screwdriver of Alsruehe cannot pivot between the three recited positions nor could the screwdriver be modified to move between the three recited positions.

Assuming *arguendo* that the hand drill of Nagel could be modified as suggested by the Examiner to include these elements, the proposed combination still does not teach or suggest the elements of Claim 1. Specifically, Alsruehe does not teach or suggest a reciprocating saw including a reciprocating spindle for supporting a tool element, the drive mechanism being operably connected to the spindle for causing reciprocation of the spindle. Rather, the screwdriver 10 of Alsruehe includes a motor 18, a transmission 20, and a rotary spindle 22 supported in a forward end of the screwdriver 10 for rotating a screwdriver bit.

In addition, Alsruehe does not teach or suggest a power tool including, among other things, a hand grip being supported for movement relative to the body between a first position, in which the first grip surface and the second grip surface are generally aligned, a second position, in which the second grip surface defines an obtuse angle with respect to the body axis, and a third position, in which the second grip surface is generally perpendicular to the first grip surface, as recited in Claim 1. Rather, the second housing member 14 of Alsruehe is connected to a rear portion 40 of the first housing member 12 for pivoting movement relative to the first housing member 12 between a first position (shown in Fig. 1), in which the first and second housing members 12, 14 are generally aligned, and a second position (shown in Fig. 2), in which the second housing member 14 is oriented at a non-perpendicular angle with respect to the first housing member 12.

Moreover, the screwdriver of Alsruehe could not be modified to facilitate movement of the second housing member 14 of the power tool 10 toward an orientation, in which a grip surface of the second housing member 14 is generally perpendicular to a grip surface of the first housing member 12. In fact, Alsruehe teaches away from modifying the power tool 10 to facilitate such movement.

Specifically, if the power tool 10 of Alsruehe were modified to include additional detents positioned along the rear portion 40 between the first and second detents 46, 48, the second housing member 14 of such a modified power tool 10 would not be able to pivot toward an orientation in which the second housing member 14 is substantially perpendicular to the first housing member 12. Rather, such a modification to the power tool 10 of Alsruehe would only enable the second housing member 14 to be pivoted toward positions in which the second housing member 14 is at an obtuse angle (i.e., a non-perpendicular angle) with respect to the first housing member 12.

Alternatively, if the power tool 10 of Alsruehe were modified to include an additional detent positioned forwardly from the first detent 46 (i.e., between the first detent 46 and a rearward end of the first housing member 12), the engagement between the rearward end of the first housing member 12 and the forward end of the second housing member 14 (see the upper portion of Fig. 4) would prevent the second housing member 14 from being pivoted about the pivot 44 toward a pivoted position which would allow the pin 90 to engage such an additional detent.

Moreover, even if it was possible to modify the power tool 10 of Alsruhe to include an additional detent positioned forwardly from the first detent 46 and even if it was possible to modify the power tool 10 of Alsruhe so that the engagement between the rearward end of the first housing member 12 and the forward end of the second housing member 14 would not prevent the second housing member 14 from being pivoted about the pivot 44 toward a pivoted position that would allow the pin 90 to engage the additional detent, the additional detent could not be positioned far enough forwardly along the periphery of the rear portion 40 of the first housing member 12 to allow the pin 90 to engage the additional detent and also allow the second housing member 14 to be pivoted about the pivot 44 toward a position in which the second housing member 14 is substantially perpendicular to the first housing member 12. Rather, even with these modifications to the power tool 10 of Alsruhe, the second housing member 14 could only pivot toward a position in which the second housing member 14 is at an obtuse angle (i.e., a non-perpendicular angle) with respect to the first housing member 12.

Similarly, if the power tool 10 of Alsruhe were modified to include an additional detent positioned forwardly from the second detent 48 (i.e., between the second detent 48 and a rearward end of the first housing member 12), the engagement between the rearward end of the first housing member 12 and the forward end of the second housing member 14 (see the lower portion of Figs. 2 and 5) would prevent the second housing member 14 from being pivoted about the pivot 44 toward a pivoted position which would allow the pin 90 to engage such an additional detent. To accommodate movement of the second housing member 14 toward such a position without causing interference between the rearward end of the first housing member 12 and the forward end of the second housing member 14, the cutout 72 would have to be enlarged by a significant amount. Alsruhe does not teach or suggest that such a modification could or should be made to the cutout 72. Moreover, such an enlargement would necessitate the removal of the switch 28 and/or the redesign of the battery 26, and Alsruhe makes no reference to how or why such modifications would or could be made and such a modification would not be obvious to a person of ordinary skill in the art of power tool design. For these and other reasons, Alsruhe does not teach or suggest the subject matter of Claim 1.

Kikuchi does not cure the deficiencies of Nagel and Alsruhe. Rather, as acknowledged by the Examiner, the power tool 10 of Kikuchi includes “a housing 14 having a body and a hand grip integrally formed with the body.” The Examiner further notes that “the body and the hand

grip [of the saw of Kikuchi] are of one single piece (14) and are therefore not adjustable with respect to each other." The fact that the body and the hand grip of the power tool 10 of Kikuchi are integrally formed teaches away from the modification suggested by the Examiner.

In addition, the structural differences between the reciprocating saw of Kikuchi and the drill of Nagel and the screwdriver of Alsruehe are significant. As illustrated in Kikuchi, Nagel, and Alsruehe and as explained below, there are significant differences between reciprocating saws and screwdrivers or drills, and these differences present significantly different design considerations, making the suggested combination of the teachings of Kikuchi and Nagel and/or Alsruehe inappropriate.

As a starting point, reciprocating saws and screwdrivers and drills are designed for entirely different construction operations, requiring significantly different design considerations. Screwdrivers and drills are generally used to tighten and loosen screws and other threaded fasteners. Drills are also used for drilling holes for such fasteners. Applicants respectfully submit that the above-described and other significant differences between the design and construction of screwdrivers and drills and of reciprocating saws provide reasons why one of ordinary skill in the art would not modify the saw 10 of Kikuchi to include a pivoting handle, such as the pivoting handles of the screwdriver disclosed by Alsruehe and/or the drill disclosed by Nagel.

Moreover, Kikuchi actually teaches away from the modification suggested by the Examiner. More particularly, in addition to being housed in a one-piece integral housing, the saw of Kikuchi is constructed such that the components of the drive mechanism could not be housed in a two-piece housing having a hand grip providing a second grip surface and being supported for movement relative to the body between a first position, in which the first grip surface and the second grip surface are generally aligned, a second position, in which the second grip surface defines an obtuse angle with respect to the body axis, and a third position, in which the second grip surface is generally perpendicular to the first grip surface. Rather, the motor 44, the motor shaft 45 secured to the motor 44, the cam shaft 16 secured to the motor shaft 45, and the drive cams 20, 22 secured to the cam shaft 16 could not be moved or reoriented within the housing 14 of the saw 10 of Kikuchi.

In addition, if even one of the motor 44, the motor shaft 45 secured to the motor 44, the cam shaft 16 secured to the motor shaft 45, and the drive cams 20, 22 were moved or reoriented

within the housing 14 of the saw 10 of Kikuchi, drive force could not be transferred from the motor 44, through the motor shaft 45, the cam shaft 16, and the drive cams 20, 22 to the follower member 26 and the follower shaft 24 to reciprocate the saw blade 46 supported by the follower shaft 24. Rather, the in-line drive arrangement of the cam oscillation assembly 12 of Kikuchi requires that the various elements of the cam oscillation assembly 12 be arranged along parallel axes. Accordingly, any reorientation of any one of the elements of the saw 10 of Kikuchi would prevent normal operation of the saw 10. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d at 902, 221 U.S.P.Q. at 1127.

For these and other reasons, Nagel, Alsruehe and Kikuchi, alone or in combination, do not teach or suggest the modification suggested by the Examiner and, in fact, the references teach away from such a combination. It is improper to combine references where the references teach away from such a combination. In re Grasselli, 713 F.2d at 743, 218 U.S.P.Q. at 779. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facia* case of obviousness of Claim 1 based upon the prior art as required by 35 U.S.C. § 103. Accordingly, independent Claim 1 is allowable. Dependent Claims 2-10 depend from Claim 1 and are allowable for the same and other reasons.

Claim 9 ultimately depends from independent Claim 1 and is allowable for at least the reasons discussed above with respect to Claim 1. As mentioned above, Nagel, Alsruehe, and Kikuchi, either alone or in combination do not teach or suggest the subject matter of Claim 1. Yang does not cure the deficiencies of Nagel, Alsruehe, and Kikuchi. Specifically, Yang does not teach or suggest, among other things, a power tool including a hand grip connected to the rearward end of the body, the hand grip providing a second grip surface and being supported for movement relative to the body between a first position, in which the first grip surface and the second grip surface are generally aligned, a second position, in which the second grip surface defines an obtuse angle with respect to the body axis, and a third position, in which the second grip surface is generally perpendicular to the first grip surface. Rather, as shown in Figs. 1 and 1-1 of Yang, the forward end of the handle 106 includes arcuately-shaped recesses for receiving the rearwardly extending arms of the body 103. The arcuately-shaped recesses limit pivoting movement of the handle 106 with respect to the body 103 and prevent the handle 106 from being

moved toward a position, in which the handle 106 is substantially perpendicular to the body 103. The configuration shown in Fig. 1 of Yang shows the furthest possible extent of pivoting movement of the handle 106 with respect to the body 103, and, even in this configuration, the handle 106 cannot be pivoted toward a position in which the handle 106 is generally perpendicular to the body 103.

In addition, Yang does not teach or suggest, among other things, a reciprocating saw comprising a reciprocating spindle for supporting a tool element, the drive mechanism being operably connected to the spindle for causing reciprocating of the spindle. Rather, the tool of Yang appears to be a screwdriver with a rotary drive arrangement. For these and other reasons, Nagel, Alsruehe, Kikuchi, and Yang, alone or in combination do not teach or suggest all the claim limitations of Claim 9. Accordingly, Claim 9 is allowable.

B. Independent Claim 12 and dependent Claims 13-22

Claim 12 recites a power tool comprising a body housing a motor and a drive mechanism driven by the motor, the body having a rearward end, a hand grip connected to the rearward end of the body, the hand grip being supported for movement relative to the body, a locking mechanism for locking the hand grip in a position relative to the body, the locking mechanism having a locked condition, in which the locking mechanism prevents movement of the hand grip relative to the body, and an unlocked position, and an actuator supported on one of the body and the hand grip and operable to move the locking mechanism between the locked condition and the unlocked condition.

Claim 12 specifies that the body provides a first grip surface and defines a body axis, wherein the hand grip provides a second grip surface, and that the hand grip is supported for movement relative to the body toward a position, in which the second grip surface is generally perpendicular to the first grip surface. Claim 12 also specifies that the power tool is a reciprocating saw, and that the reciprocating saw further comprises a reciprocating spindle for supporting a tool element, the drive mechanism being operably connected to the spindle for causing reciprocation of the spindle.

As noted by the Examiner, Nagel does not teach or suggest a body housing a motor and a drive mechanism driven by the motor. Nagel also does not teach or suggest a reciprocating saw including a reciprocating spindle for supporting a tool element, the drive mechanism being

operably connected to the spindle for causing reciprocation of the spindle. Rather, the hand drill of Nagel includes a rotary drive arrangement for *rotating* a chuck and a bit supported in the chuck. Moreover, given the lack of any disclosure regarding the interior of the drill of Nagel, only through speculation is it possible to image how a drive mechanism and a motor could be arranged within the drill of Nagel and how these and other elements would be electrically connected while allowing pivoting movement of the drill.

In addition and as explained in more detail below, given the lack of disclosure, it is impossible to imagine how these unseen elements would be modified to include the elements of the claimed invention.

Further, Nagel does not teach or suggest a power tool including a locking mechanism for locking the hand grip in a position relative to the body, the locking mechanism having a locked condition, in which the locking mechanism prevents movement of the hand grip relative to the body, and an unlocked position, and an actuator supported on one of the body and the hand grip and operable to move the locking mechanism between the locked condition and the unlocked condition. There is no indication that the two housing portions of the hand drill of Nagel can be locked in position relative to one another. Moreover, the only element resembling an “actuator” included on the hand drill of Nagel appears to be a power switch located on a back side of the lower housing portion. For these and other reasons, Nagel does not teach or suggest the subject matter of Claim 12.

The Examiner argues that “[i]t would have been obvious to one of ordinary skill in the art to modify [the drill of] Nagel by providing the power tool with a motor, a drive mechanism, a switch assembly, a wire arrangement, a locking mechanism, an actuator, and a biasing means to achieve a workable power tool as taught by Alsruhe.” As explained below in more detail, Applicants respectfully disagree and submit that Alsruhe does not cure the deficiencies of Nagel. Moreover, Applicants respectfully submit that the Examiner fails to explain how the various elements, including a motor, a drive mechanism, a switch assembly, a wire arrangement, a locking mechanism, and an actuator would be arranged within the housing of the hand drill of Nagel if the drill were modified as suggested by the Examiner and how power would be transmitted between these elements without allowing any wires to be pinched during pivoting. Presumably, the Examiner is suggesting that these elements would be arranged within the housing of the hand drill of Nagel in a manner similar to that disclosed in the screwdriver of

Alsruehe. However, as explained below, the screwdriver of Alsruehe cannot pivot between the three recited positions nor could the screwdriver be modified to move between the three recited positions.

Assuming *arguendo* that the hand drill of Nagel could be modified as suggested by the Examiner to include these elements, the proposed combination still does not teach or suggest the elements of Claim 12. Specifically, Alsruehe does not teach or suggest a reciprocating saw including a reciprocating spindle for supporting a tool element, the drive mechanism being operably connected to the spindle for causing reciprocation of the spindle. Rather, the screwdriver 10 of Alsruehe includes a motor 18, a transmission 20, and a rotary spindle 22 supported in a forward end of the screwdriver 10 for rotating a screwdriver bit.

In addition, Alsruehe does not teach or suggest a power tool including, among other things, a hand grip being supported for movement relative to the body, that the body provides a first grip surface and defines a body axis, wherein the hand grip provides a second grip surface, and that the hand grip is supported for movement relative to the body toward a position, in which the second grip surface is generally perpendicular to the first grip surface, as recited in Claim 12. Rather, the second housing member 14 of Alsruehe is connected to a rear portion 40 of the first housing member 12 for pivoting movement relative to the first housing member 12 between a first position (shown in Fig. 1), in which the first and second housing members 12, 14 are generally aligned, and a second position (shown in Fig. 2), in which the second housing member 14 is oriented at a non-perpendicular angle with respect to the first housing member 12.

Moreover, the screwdriver of Alsruehe could not be modified to facilitate movement of the second housing member 14 of the power tool 10 toward an orientation, in which a grip surface of the second housing member 14 is generally perpendicular to a grip surface of the first housing member 12. In fact, Alsruehe teaches away from modifying the power tool 10 to facilitate such movement.

Specifically, if the power tool 10 of Alsruehe were modified to include additional detents positioned along the rear portion 40 between the first and second detents 46, 48, the second housing member 14 of such a modified power tool 10 would not be able to pivot toward an orientation in which the second housing member 14 is substantially perpendicular to the first housing member 12. Rather, such a modification to the power tool 10 of Alsruehe would only enable the second housing member 14 to be pivoted toward positions in which the second

housing member 14 is at an obtuse angle (i.e., a non-perpendicular angle) with respect to the first housing member 12.

Alternatively, if the power tool 10 of Alsrue were modified to include an additional detent positioned forwardly from the first detent 46 (i.e., between the first detent 46 and a rearward end of the first housing member 12), the engagement between the rearward end of the first housing member 12 and the forward end of the second housing member 14 (see the upper portion of Fig. 4) would prevent the second housing member 14 from being pivoted about the pivot 44 toward a pivoted position which would allow the pin 90 to engage such an additional detent.

Moreover, even if it was possible to modify the power tool 10 of Alsrue to include an additional detent positioned forwardly from the first detent 46 and even if it was possible to modify the power tool 10 of Alsrue so that the engagement between the rearward end of the first housing member 12 and the forward end of the second housing member 14 would not prevent the second housing member 14 from being pivoted about the pivot 44 toward a pivoted position that would allow the pin 90 to engage the additional detent, the additional detent could not be positioned far enough forwardly along the periphery of the rear portion 40 of the first housing member 12 to allow the pin 90 to engage the additional detent and also allow the second housing member 14 to be pivoted about the pivot 44 toward a position in which the second housing member 14 is substantially perpendicular to the first housing member 12. Rather, even with these modifications to the power tool 10 of Alsrue, the second housing member 14 could only pivot toward a position in which the second housing member 14 is at an obtuse angle (i.e., a non-perpendicular angle) with respect to the first housing member 12.

Similarly, if the power tool 10 of Alsrue were modified to include an additional detent positioned forwardly from the second detent 48 (i.e., between the second detent 48 and a rearward end of the first housing member 12), the engagement between the rearward end of the first housing member 12 and the forward end of the second housing member 14 (see the lower portion of Figs. 2 and 5) would prevent the second housing member 14 from being pivoted about the pivot 44 toward a pivoted position which would allow the pin 90 to engage such an additional detent. To accommodate movement of the second housing member 14 toward such a position without causing interference between the rearward end of the first housing member 12 and the forward end of the second housing member 14, the cutout 72 would have to be enlarged

by a significant amount. Alsruehe does not teach or suggest that such a modification could or should be made to the cutout 72. Moreover, such an enlargement would necessitate the removal of the switch 28 and/or the redesign of the battery 26, and Alsruehe makes no reference to how or why such modifications would or could be made and such a modification would not be obvious to a person of ordinary skill in the art of power tool design. For these and other reasons, Alsruehe does not teach or suggest the subject matter of Claim 12.

Kikuchi does not cure the deficiencies of Nagel and Alsruehe. Rather, as acknowledged by the Examiner, the power tool 10 of Kikuchi includes “a housing 14 having a body and a hand grip integrally formed with the body.” The Examiner further notes that “the body and the hand grip [of the saw of Kikuchi] are of one single piece (14) and are therefore not adjustable with respect to each other.” The fact that the body and the hand grip of the power tool 10 of Kikuchi are integrally formed teaches away from the modification suggested by the Examiner.

In addition, the structural differences between the reciprocating saw of Kikuchi and the drill of Nagel and the screwdriver of Alsruehe are significant. As illustrated in Kikuchi, Nagel, and Alsruehe and as explained below, there are significant differences between reciprocating saws and screwdrivers or drills, and these differences present significantly different design considerations, making the suggested combination of the teachings of Kikuchi and Nagel and/or Alsruehe inappropriate.

As a starting point, reciprocating saws and screwdrivers and drills are designed for entirely different construction operations, requiring significantly different design considerations. Screwdrivers and drills are generally used to tighten and loosen screws and other threaded fasteners. Drills are also used for drilling holes for such fasteners. Applicants respectfully submit that the above-described and other significant differences between the design and construction of screwdrivers and drills and of reciprocating saws provide reasons why one of ordinary skill in the art would not modify the saw 10 of Kikuchi to include a pivoting handle, such as the pivoting handles of the screwdriver disclosed by Alsruehe and/or the drill disclosed by Nagel.

Moreover, Kikuchi actually teaches away from the modification suggested by the Examiner. More particularly, in addition to being housed in a one-piece integral housing, the saw of Kikuchi is constructed such that the components of the drive mechanism could not be housed in a two-piece housing having a body that provides a first grip surface and defines a body

axis, that the hand grip provides a second grip surface, and that the hand grip is supported for movement relative to the body toward a position, in which the second grip surface is generally perpendicular to the first grip surface. Rather, the motor 44, the motor shaft 45 secured to the motor 44, the cam shaft 16 secured to the motor shaft 45, and the drive cams 20, 22 secured to the cam shaft 16 could not be moved or reoriented within the housing 14 of the saw 10 of Kikuchi.

In addition, if even one of the motor 44, the motor shaft 45 secured to the motor 44, the cam shaft 16 secured to the motor shaft 45, and the drive cams 20, 22 were moved or reoriented within the housing 14 of the saw 10 of Kikuchi, drive force could not be transferred from the motor 44, through the motor shaft 45, the cam shaft 16, and the drive cams 20, 22 to the follower member 26 and the follower shaft 24 to reciprocate the saw blade 46 supported by the follower shaft 24. Rather, the in-line drive arrangement of the cam oscillation assembly 12 of Kikuchi requires that the various elements of the cam oscillation assembly 12 be arranged along parallel axes. Accordingly, any reorientation of any one of the elements of the saw 10 of Kikuchi would prevent normal operation of the saw 10. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d at 902, 221 U.S.P.Q. at 1127.

For these and other reasons, Nagel, Alsruehe and Kikuchi, alone or in combination, do not teach or suggest the modification suggested by the Examiner and, in fact, the references teach away from such a combination. It is improper to combine references where the references teach away from such a combination. In re Grasselli, 713 F.2d at 743, 218 U.S.P.Q. at 779. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facia* case of obviousness of Claim 12 based upon the prior art as required by 35 U.S.C. § 103. Accordingly, Claim 12 is allowable. Claims 13-21 depend from independent Claim 12 and are allowable for the same and other reasons.

Claim 20 ultimately depends from independent Claim 12 and is allowable for at least the reasons discussed above with respect to Claim 12. As mentioned above, Nagel, Alsruehe, and Kikuchi do not teach or suggest the subject matter of Claim 12. Yang does not cure the deficiencies of Nagel, Alsruehe, and Kikuchi. Rather than re-present the arguments set forth above with respect to this contention, for brevity's sake, Applicants refer to the discussion above

for Claim 9. With respect to Claim 20, the same arguments apply to the lack of a suggestion to modify the power tool 10 of Nagel, Alsruehe, and Kikuchi as suggested by the Examiner or that such a modified power tool would or could include all of the claim limitations of Claim 9. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facia* case of obviousness of Claim 12 based upon the prior art as required by 35 U.S.C. § 103. For these and other reasons, Nagel, Alsruehe, Kikuchi, and Yang, alone or in combination do not teach or suggest all the claim limitations of Claim 20. Accordingly, Claim 20 is allowable.

C. Independent Claim 23 and dependent Claims 24-26

Claim 23 recites a method of operating a power tool, the power tool including a body housing a motor and a drive mechanism driven by the motor and providing a first grip surface, the body having a rearward end and defining a body axis, a hand grip connected to the rearward end of the body, the hand grip providing a second grip surface and being supported for movement relative to the body, and a reciprocating spindle for supporting a tool element. The method comprises the acts of positioning the hand grip in a first position in which the first grip surface and the second grip surface are generally aligned, operating the power tool in the first position, moving the hand grip relative to the body to a second position in which the second grip surface defines an obtuse angle with respect to the body axis, operating the power tool in the second position, moving the hand grip relative to the body to a third position in which the second grip surface is generally perpendicular to the first grip surface, and operating the power tool in the third position. Claim 23 specifies that the acts of operating the power tool in the first, second, and third positions include reciprocating one of the tool element and the spindle relative to the body.

As noted by the Examiner, Nagel does not teach or suggest a power tool having a body housing a motor and a drive mechanism driven by the motor. Nagel also does not teach or suggest a power tool including a reciprocating spindle for supporting a tool element and that the acts of operating the power tool in the first, second, and third positions includes reciprocating one of the tool element and the spindle relative to the body. Rather, the hand drill of Nagel includes a rotary drive arrangement for *rotating* a chuck and a bit supported in the chuck. Moreover, given the lack of any disclosure regarding the interior of the drill of Nagel, only through speculation is it possible to image how a drive mechanism and a motor could be

arranged within the drill of Nagel and how these and other elements would be electrically connected while allowing pivoting movement of the drill.

In addition and as explained in more detail below, given the lack of disclosure, it is impossible to imagine how these unseen elements would be modified to include the elements of the claimed invention. For these and other reasons, Nagel does not teach or suggest the subject matter of Claim 23.

The Examiner argues that “[i]t would have been obvious to one of ordinary skill in the art to modify [the drill of] Nagel by providing the power tool with a motor, a drive mechanism, a switch assembly, a wire arrangement, a locking mechanism, an actuator, and a biasing means to achieve a workable power tool as taught by Alsruehe.” As explained below in more detail, Applicants respectfully disagree and submit that Alsruehe does not cure the deficiencies of Nagel. Moreover, Applicants respectfully submit that the Examiner fails to explain how the various elements, including a motor, a drive mechanism, a switch assembly, a wire arrangement, a locking mechanism, and an actuator would be arranged within the housing of the hand drill of Nagel if the screwdriver were modified as suggested by the Examiner and how power would be transmitted between these elements without allowing any wires to be pinched during pivoting. Presumably, the Examiner is suggesting that these elements would be arranged within the housing of the hand drill of Nagel in a manner similar to that disclosed in the screwdriver of Alsruehe. However, as explained below, the screwdriver of Alsruehe cannot pivot between the three recited positions nor could the screwdriver be modified to move between the three recited positions.

Assuming *arguendo* that the hand drill of Nagel could be modified as suggested by the Examiner to include these elements, the proposed combination still does not teach or suggest the elements of Claim 23. Specifically, Alsruehe does not teach or suggest a reciprocating saw including a reciprocating spindle for supporting a tool element, the drive mechanism being operably connected to the spindle for causing reciprocation of the spindle. Rather, the screwdriver 10 of Alsruehe includes a motor 18, a transmission 20, and a rotary spindle 22 supported in a forward end of the screwdriver 10 for rotating a screwdriver bit.

In addition, Alsruehe does not teach or suggest a method of operating a power tool including the acts of positioning the hand grip in a first position in which the first grip surface and the second grip surface are generally aligned, operating the power tool in the first position,

moving the hand grip relative to the body to a second position in which the second grip surface defines an obtuse angle with respect to the body axis, operating the power tool in the second position, moving the hand grip relative to the body to a third position in which the second grip surface is generally perpendicular to the first grip surface, and operating the power tool in the third position, as recited in Claim 23. Rather, the second housing member 14 of Alsrue is connected to a rear portion 40 of the first housing member 12 for pivoting movement relative to the first housing member 12 between a first position (shown in Fig. 1), in which the first and second housing members 12, 14 are generally aligned, and a second position (shown in Fig. 2), in which the second housing member 14 is oriented at a non-perpendicular angle with respect to the first housing member 12.

Moreover, the screwdriver of Alsrue could not be modified to facilitate movement of the second housing member 14 of the power tool 10 toward an orientation, in which a grip surface of the second housing member 14 is generally perpendicular to a grip surface of the first housing member 12. In fact, Alsrue teaches away from modifying the power tool 10 to facilitate such movement.

Specifically, if the power tool 10 of Alsrue were modified to include additional detents positioned along the rear portion 40 between the first and second detents 46, 48, the second housing member 14 of such a modified power tool 10 would not be able to pivot toward an orientation in which the second housing member 14 is substantially perpendicular to the first housing member 12. Rather, such a modification to the power tool 10 of Alsrue would only enable the second housing member 14 to be pivoted toward positions in which the second housing member 14 is at an obtuse angle (i.e., a non-perpendicular angle) with respect to the first housing member 12.

Alternatively, if the power tool 10 of Alsrue were modified to include an additional detent positioned forwardly from the first detent 46 (i.e., between the first detent 46 and a rearward end of the first housing member 12), the engagement between the rearward end of the first housing member 12 and the forward end of the second housing member 14 (see the upper portion of Fig. 4) would prevent the second housing member 14 from being pivoted about the pivot 44 toward a pivoted position which would allow the pin 90 to engage such an additional detent.

Moreover, even if it was possible to modify the power tool 10 of Alsruhe to include an additional detent positioned forwardly from the first detent 46 and even if it was possible to modify the power tool 10 of Alsruhe so that the engagement between the rearward end of the first housing member 12 and the forward end of the second housing member 14 would not prevent the second housing member 14 from being pivoted about the pivot 44 toward a pivoted position that would allow the pin 90 to engage the additional detent, the additional detent could not be positioned far enough forwardly along the periphery of the rear portion 40 of the first housing member 12 to allow the pin 90 to engage the additional detent and also allow the second housing member 14 to be pivoted about the pivot 44 toward a position in which the second housing member 14 is substantially perpendicular to the first housing member 12. Rather, even with these modifications to the power tool 10 of Alsruhe, the second housing member 14 could only pivot toward a position in which the second housing member 14 is at an obtuse angle (i.e., a non-perpendicular angle) with respect to the first housing member 12.

Similarly, if the power tool 10 of Alsruhe were modified to include an additional detent positioned forwardly from the second detent 48 (i.e., between the second detent 48 and a rearward end of the first housing member 12), the engagement between the rearward end of the first housing member 12 and the forward end of the second housing member 14 (see the lower portion of Figs. 2 and 5) would prevent the second housing member 14 from being pivoted about the pivot 44 toward a pivoted position which would allow the pin 90 to engage such an additional detent. To accommodate movement of the second housing member 14 toward such a position without causing interference between the rearward end of the first housing member 12 and the forward end of the second housing member 14, the cutout 72 would have to be enlarged by a significant amount. Alsruhe does not teach or suggest that such a modification could or should be made to the cutout 72. Moreover, such an enlargement would necessitate the removal of the switch 28 and/or the redesign of the battery 26, and Alsruhe makes no reference to how or why such modifications would or could be made and such a modification would not be obvious to a person of ordinary skill in the art of power tool design. For these and other reasons, Alsruhe does not teach or suggest the subject matter of Claim 23.

Kikuchi does not cure the deficiencies of Nagel and Alsruhe. Rather, as acknowledged by the Examiner, the power tool 10 of Kikuchi includes “a housing 14 having a body and a hand grip integrally formed with the body.” The Examiner further notes that “the body and the hand

grip [of the saw of Kikuchi] are of one single piece (14) and are therefore not adjustable with respect to each other." The fact that the body and the hand grip of the power tool 10 of Kikuchi are integrally formed teaches away from the modification suggested by the Examiner.

In addition, the structural differences between the reciprocating saw of Kikuchi and the drill of Nagel and the screwdriver of Alsruehe are significant. As illustrated in Kikuchi, Nagel, and Alsruehe and as explained below, there are significant differences between reciprocating saws and screwdrivers or drills, and these differences present significantly different design considerations, making the suggested combination of the teachings of Kikuchi and Nagel and/or Alsruehe inappropriate.

As a starting point, reciprocating saws and screwdrivers and drills are designed for entirely different construction operations, requiring significantly different design considerations. Screwdrivers and drills are generally used to tighten and loosen screws and other threaded fasteners. Drills are also used for drilling holes for such fasteners. Applicants respectfully submit that the above-described and other significant differences between the design and construction of screwdrivers and drills and of reciprocating saws provide reasons why one of ordinary skill in the art would not modify the saw 10 of Kikuchi to include a pivoting handle, such as the pivoting handles of the screwdriver disclosed by Alsruehe and/or the drill disclosed by Nagel.

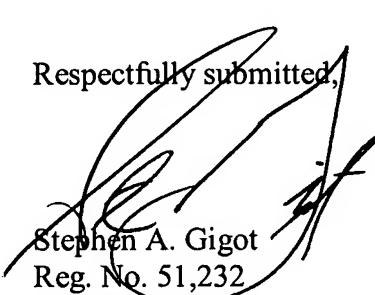
Moreover, Kikuchi actually teaches away from the modification suggested by the Examiner. More particularly, in addition to being housed in a one-piece integral housing, the saw of Kikuchi is constructed such that the components of the drive mechanism could not be housed in a two-piece housing and such that the hand grip could not be moved relative to the body toward a first position in which the first grip surface and the second grip surface are generally aligned, the hand grip could not be moved relative to the body toward a second position in which the second grip surface defines an obtuse angle with respect to the body axis, and the hand grip could not be moved relative to the body toward a third position in which the second grip surface is generally perpendicular to the first grip surface. Rather, the motor 44, the motor shaft 45 secured to the motor 44, the cam shaft 16 secured to the motor shaft 45, and the drive cams 20, 22 secured to the cam shaft 16 could not be moved or reoriented within the housing 14 of the saw 10 of Kikuchi.

In addition, if even one of the motor 44, the motor shaft 45 secured to the motor 44, the cam shaft 16 secured to the motor shaft 45, and the drive cams 20, 22 were moved or reoriented within the housing 14 of the saw 10 of Kikuchi, drive force could not be transferred from the motor 44, through the motor shaft 45, the cam shaft 16, and the drive cams 20, 22 to the follower member 26 and the follower shaft 24 to reciprocate the saw blade 46 supported by the follower shaft 24. Rather, the in-line drive arrangement of the cam oscillation assembly 12 of Kikuchi requires that the various elements of the cam oscillation assembly 12 be arranged along parallel axes. Accordingly, any reorientation of any one of the elements of the saw 10 of Kikuchi would prevent normal operation of the saw 10. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d at 902, 221 U.S.P.Q. at 1127.

For these and other reasons, Nagel, Alsruehe and Kikuchi, alone or in combination, do not teach or suggest the modification suggested by the Examiner and, in fact, the references teach away from such a combination. It is improper to combine references where the references teach away from such a combination. In re Grasselli, 713 F.2d at 743, 218 U.S.P.Q. at 779. Therefore, Applicants respectfully submit that the Examiner has failed to present a *prima facia* case of obviousness of Claim 23 based upon the prior art as required by 35 U.S.C. § 103. Accordingly, Claim 23 is allowable. Claims 24-26 depend from independent Claim 23 and are allowable for the same and other reasons.

CONCLUSION

In view of the foregoing, entry of the present Amendment and allowance of the application are respectfully requested.

Respectfully submitted,

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